

## REMARKS

The Office Action dated April 28, 2005, has been received and reviewed.

Claims 1-6, 8-30, 42-49, 75-88, and 98-103 are currently pending and under consideration in the above-referenced application. Of these, claims 98-101 and 103 have been allowed, claims 9, 20, 78, 80, and 87 recite allowable subject matter but depend from rejected base claims, and claims 1-6, 8, 10-19, 21-30, 42-49, 75-77, 79, 81-86, 88, and 102 stand rejected.

Reconsideration of the above-referenced application is respectfully requested.

### Rejections Under 35 U.S.C. § 103(a)

Claims 1-6, 8, 10-19, 21-30, 42-49, 75-77, 79, 81-86, 88, and 102 stand rejected under 35 U.S.C. § 103(a) for reciting subject matter which is assertedly unpatentable over the subject matter taught in U.S. Patent 4,440,177 to Anderson et al. (hereinafter “Anderson”), in view of teachings from U.S. Patent 5,789,660 to Kofoed et al. (hereinafter “Kofoed”) and U.S. Patent 6,475,158 to Orr et al. (hereinafter “Orr”).

The standard for establishing and maintaining a rejection under 35 U.S.C. § 103(a) is set forth in M.P.E.P. § 706.02(j), which provides:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.  
*In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

It is respectfully submitted that Kofoed does not qualify as prior art to any of the claims of the above-referenced application and, therefore, cannot be relied upon in a rejection of any of the claims of the above-referenced application.

This is so because all of the elements recited in the independent claims of the above-referenced application are adequately supported by the subject matter disclosed in the

parent, non-provisional applications. In addition, these parent, nonprovisional applications were filed, or have priority dates, that precede the filing date of one or more references upon which the 35 U.S.C. § 103(a) rejections are based. M.P.E.P. § 201.11. Specifically, each element recited in all of the independent claims of the above-referenced application is disclosed in one or more of U.S. Application serial no. 08/680,492, filed July 15, 1996 (which issued as Kofoed), and U.S. Applications serial nos. 09/128,897 and 09/128,918, both filed August 4, 1998. Orr issued from an application that was not filed until October 24, 2000. Therefore, Orr does not qualify as prior art to the subject matter recited in the claims of the above-referenced application.

Moreover, as indicated above, a claim for priority to the filing date of Kofoed has been made in the above-referenced application. As a result of that specific priority claim, applicants are entitled to pursue claims that are directed to the subject matter originally disclosed in Kofoed. Kofoed discloses an airway adapter that includes features for monitoring at least two aspects of a subject's respiration. It appears that Kofoed has been relied upon in the rejection for its teaching of a component for detecting a substance in respiration without diverting respiratory gases from the housing in which a respiratory flow detection component is formed. *See* Office Action of April 28, 2005, page 2. The novelty of these teachings is readily apparent from the fact that the Office has not and cannot cite any other art that teaches or suggests the incorporation of features from two or more respiratory sensors into a single airway adapter. In view of the novelty of the subject matter taught in Kofoed, applicants are clearly entitled to seek claims that are broadly drawn to such subject matter, including claims that are more generic than independent claims 1, 22, 42, 75, 82, and 102 of the above-referenced application. As such, Kofoed cannot be relied upon in rejecting any of the claims of the above-referenced application. *See, contra.*, M.P.E.P. § 201.11 VI.

In addition, it is respectfully submitted that a *prima facie* case of obviousness has not been established against any of claims 1-6, 8, 10-19, 21-30, 42-49, 75-77, 79, 81-86, 88, or 102. Anderson teaches a respiratory monitoring system that includes a nosepiece and separate flow, carbon dioxide, and oxygen sensors. *See* col. 5, line 24, to col. 4, line 24.

Kofoed teaches an integrated airway adapter, positionable along a breathing tube, that includes a housing with elements of both a differential flow sensor and an infrared-type sensor. Orr discloses a calorimeter that includes a flow meter and a separate oxygen sensor, which may comprise a luminescence quenching-type sensor.

It is respectfully submitted that, without improperly relying upon the hindsight provided by the disclosure of the above-referenced application, one of ordinary skill in the art would not have been motivated to combine the teachings of Anderson, Kofoed, and Orr in the manner that has been asserted. The teachings of Anderson are directed to a system for with separate sensors for analyzing exhaled respiratory gases. *See, e.g.*, FIG. 2; the top of which illustrates gas sources, and the bottom of which shows a system for monitoring exhaled respiratory gases. *See also*, col. 5, line 24, to col. 6, line 24. The calorimetry system of Orr, likewise, includes separate flow and oxygen sensors that only receive exhaled gases. *See, e.g.*, col. 3, lines 34-38. Thus, neither of these systems is configured to be positioned along a breathing circuit. In contrast, the teachings of Kofoed are directed to an "airway adapter" that includes features of multiple sensors in a single housing. Airway adapters are, by definition, configured for placement along a breathing circuit that communicates with airway. Thus, one of ordinary skill in the art would not have been motivated to incorporate teachings from Kofoed into the system of Anderson. As such, a *prima facie* case of obviousness has not been established.

Therefore, under 35 U.S.C. § 103(a), the subject matter to which each of claims 1-6, 8, 10-19, 21-30, 42-49, 75-77, 79, 81-86, 88, and 102 is directed is allowable over the subject matter taught in Anderson, Kofoed, and Orr.

Withdrawal of the 35 U.S.C. § 103(a) rejections of claims 1-6, 8, 10-19, 21-30, 42-49, 75-77, 79, 81-86, 88, and 102 is respectfully requested.

#### Allowable Subject Matter

The allowance of claims 98-101 and 103 and the indication that claims 9, 20, 78, 80, 85, and 87 are directed to allowable subject matter are gratefully acknowledged. None of claims 9,

20, 78, 80, 85, and 87 has been amended to independent form, however, as the claims from which they depend are also believed to be allowable.

### CONCLUSION

It is respectfully submitted that each of claims 1-6, 8-30, 42-49, 75-88, and 98-103 is allowable. An early Notice of Allowability is respectfully solicited, as is an indication that the above-referenced application has been passed for issuance. If any issues preventing allowance of the above-referenced application remain which might be resolved by way of a telephone conference, the Office is kindly invited to contact the undersigned attorney.

Respectfully submitted,



Brick G. Power  
Registration No. 38,581  
Attorney for Applicants  
TRASKBRITT, PC  
P.O. Box 2550  
Salt Lake City, Utah 84110-2550  
Telephone: 801-532-1922

Date: July 28, 2005  
BGP/djp:eg  
Document in ProLaw